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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,421	10/31/2003	Eddie Lane Smitherman	047040-00001	2070

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EXAMINER
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BLAKE, CAROLYN T

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/699,421

Applicant(s)

SMITHERMAN, EDDIE LANE

Examiner

Carolyn T. Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.  
4a) Of the above claim(s) 3-27, 29, 38-47, 49, 50 and 52-54 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 28, 30-37, 48 and 51 is/are rejected.  
7) ☒ Claim(s) 2 and 48 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I and Species V (claims 2, 28-37, and 51) in the reply filed on May 17, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

In addition, claims 1 and 48 read on the elected species and are being examined. However, claim 29 does not read on the elected species and was not examined.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "42" has been used to designate both a pivot pin and a cylinder in FIG 1.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 11, 13, 86, 95, and 97.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

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any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

5. The disclosure is objected to because of the following informalities:

- Page 3, line 13: The phrase "pair of reels provides" should be changed to -  
-pair of reels provide- -.
- Page 9, line 8: The reference number for the cutting assembly should be changed from "118" to - -120- - in order to agree with the drawings.

Appropriate correction is required.

***Claim Objections***

6. Claim 2 is objected to because of the following informalities: "the means...is adapted" should be changed to - -the means...are adapted- -. Appropriate correction is required.

7. Claim 48 is objected to because of the following informalities: the phrase "the group" (line 2) lacks proper antecedent. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 2, 28, and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear how relative linear movement between the boom and the arm is prevented, as it appears the expansion and contraction of the telescoping boom would classify as such.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2, 28, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how relative linear movement between the boom and the arm is prevented, as it appears the expansion and contraction of the telescoping boom would classify as such.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, 28, 30-33, 48, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Mullet (3,032,956).

Regarding claim 1, Mullet discloses a tree trimmer comprising: a means of transportation; a swing frame (14/29/30) swingably connected about a substantially vertically axis on the means of transportation; an arm (24/25) pivotally connected about a substantially horizontal axis on the swing frame; a telescoping boom (20/32)

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connected with the arm; means (26) for detachably connecting the telescoping boom with the arm; and cutting means (2) mounted about a first end of the telescoping boom.

Regarding claim 2, Mullet discloses the means of connecting the telescoping boom with the arm are adapted and arranged to prevent relative linear movement between the boom and arm to the same extent disclosed by Applicant.

Regarding claim 28, Mullet discloses a tree trimming apparatus comprising: a telescoping boom assembly (20/32) detachably connected with an arm (24/25) in an arrangement which prevents linear relative movement between the arm and the telescoping boom assembly; and cutting means (2) mounted about a first end of the telescoping boom assembly.

Regarding claim 30, Mullet discloses the telescoping boom assembly includes a telescoping boom (20/32), a telescoping boom receiving portion (39), and an arm receiving portion (unnumbered bracket connected to the boom by 26, see FIG 6).

Regarding claim 31, Mullet discloses the telescoping boom assembly is adapted and arranged to be powered by a power source (3) and controlled by a set of controls 44-49) that are integral with an existing means of transportation.

Regarding claim 32, Mullet discloses the arm receiving portion comprises a first mounting bracket (unnumbered, FIG 6) adjacent to the rear end of the arm receiving portion.

Regarding claim 33, Mullet discloses the arm receiving portion comprises a second mounting bracket (unnumbered, FIG 6) adjacent the rear end of the arm receiving portion.

Regarding claim 48, Mullet discloses a tree trimming apparatus comprising: an arm (24/25) connected with a means of transportation selected from a group consisting of a tractor, backhoe, backhoe loader, and material handling track; a telescoping boom assembly (20/32) connected with the arm; and a cutting means (2) connected with the telescoping boom assembly.

Regarding claim 51, Mullet discloses the means of connecting the telescoping boom assembly with the arm are adapted and arranged to prevent relative linear movement between the boom and arm to the same extent disclosed by Applicant.

***Claim Rejections - 35 USC § 103***

14. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullet as applied to claims 28 and 30 above, and further in view of Hickman (4,269,241). Mullet discloses the apparatus substantially as claimed, but fails to disclose a reel or roller. However, Hickman discloses a tree trimming apparatus comprising a telescoping boom assembly (20) and cutting means (30) wherein the boom assembly comprises a first reel (113a) and a second reel (113b), wherein the first reel is positioned adjacent to a side of the boom assembly and the second reel is positioned adjacent to another side of the boom assembly. Furthermore, Hickman discloses a first roller (11) and a second roller (112), wherein the first roller and the second roller are located above a substantially horizontal plane bisecting a bracket (23). Hickman discloses at least one reel and at least one roller are positioned adjacent the boom assembly, and a conduit (110) extends between the reel and roller. This system of rollers, reels, and conduits work together to extend and contract the telescoping

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boom using hydraulic pressure. Specifically, the roller and reels prevent tangling of the hydraulic line while allowing for increased movement of the boom. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide rollers and reels, as disclosed by Hickman, with the Mullet device for the purpose of preventing conduit tangling while increasing boom movement.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shrewsbury (2,694,421), Hamilton (3,482,611), Larson et al (3,487,864), McVaugh (3,799,016), Webset (4,703,612), and Gano (4,728,249) disclose tree trimmers.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CB  
July 14, 2005



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